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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,183	05/24/2001	Jaclyn R. Goldstein	44554/257852	2998

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EXAMINER

SMITH, TRACI L

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,183

Applicant(s)

GOLDSTEIN, JACLYN R.

Examiner

Traci L Smith

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to communications filed on May 24, 2001.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6, 19 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the step of actually submitting/placing an order for the customized design. The above claims reference authorizing payment, however there are no steps in the process on which financing was required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5, 7, 9-12, 14-15 and 20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6351212 B1 Krinsky; Filed January 5, 2000. Method of Preparing customized wallpaper panels.

6. As to claims 1, 9 and 20 Krinsky teaches:
 - a. Storing and displaying wallpaper designs(C. 4 I. 12-13)
 - b. Receiving and displaying user selection(C. 4 I. 17-19)
 - c. Transmitting and printing design(C. 4 I. 25-27).
7. As to claim 2 Krinsky teaches designs stored in a database.(C. 5 I. 14-15)
8. As to claims 3-4, 14-15 and 21 Krinsky teaches displaying by a remote device(C. 4 I. 12-13).
9. As to claims 5, 10 and 22 Krinsky teaches translating data to a format to be printed(C. 4 I. 30-33).
10. As to claim 7 Krinsky teaches the parameter of color(C. 3 I. 5-10)
11. As to claim 11 Krinsky teaches printing user selected design(C. 2. I. 58-60)
12. As to claim 12 Krinsky teaches a printing device for printing the digital image(C. 45-47).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claims 6, 8, 13, 16-19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6351212 B1 Krinsky; as applied to claims 1-5, 7, 9-12, 14-15 and 20-22 above, and further in view of US Patent Publication US 20010047250 A1 Schuller et al; Filing date February 10, 2000; Interactive Decorating System.

16. As to claims 6, 19 and 23 Krinsky teaches a method of customizing wallpaper however it doesn't teach a method of purchasing the design. Schuller teaches décor customizing that allows the user to purchase the design.(Pg. 2 ¶ 0022) Although neither Schuller or Krinsky teaches the method of electronic funds transfer explicitly step by step this process is well known in the art as described in the applicants specification on page 12, therefore is inherent to complete the steps for electronic funds transfer. It would have been obvious to one skilled in the art at the time of invention to combine the teaches of Schuller with Krinsky to continue to shorten the space of time in which the user receives the design.

17. As to claims 8, 13 and 17 Krinsky teaches a method of customizing wallpaper digitally. However, Krinsky fails to explicitly teach it over a network. Schuller teaches a customizing system over a network via the web.(Pg. 1 ¶ 0001). It would have been obvious to one skilled in the art at the time of invention to combine the teaches of Schuller with Krinsky to continue to save time and effort of the user.

18. As to claim 16 Krinsky teaches a system for displaying a design, however Krinsky fails to teach the device connected to an operating system for browsing. Schuller teaches a device capable of querying and transmitting records related to decorative material. (Pg. 1 ¶ 0007). It would have been obvious to one skilled in the art at the time of invention to combine the teaches of Schuller and Krinsky so as to allow the user to search designs to see if there is something already there they want or something they want to change.

19. As to claim 18 Krinsky teaches a system for creating customized designs. However, Krinsky fails to explicitly teach a storage method for the designs. Schuller teaches a system for customizing and a method for which to store the designs. (Pg. 2 ¶ 0023). Although, Schuller doesn't explicitly teach storing each specific data claimed the type of data it is non-functional and does not render the claim patentably different. These differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps would be performed regardless of the type of data being stored. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see in re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 44(Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ 2d 1031(Fed. Cir. 1994).

Conclusion

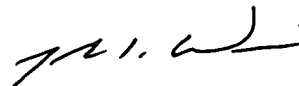
20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. BusinessWire article entitled "Women.com Networks, House

Beautiful Magazine and the Learning Company Introduce House Beautiful Interactive Interiors.”; March 30, 1999 discusses the launching of a website that allow the user to envision and design decorating styles. Foreign Patent JP 2003013371A is a methods to make wallpaper including changeable information images according to the users preferences.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L Smith whose telephone number is (703)605-1155. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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